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10/606,533	06/26/2003	James M. Rhodes	DEP5054	5756

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EXAMINER

ROGERS, KRISTIN D

ART UNIT PAPER NUMBER

3736

DATE MAILED: 02/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/606,533	<b>Applicant(s)</b> RHODES ET AL.	
	<b>Examiner</b> Kristin D. Rogers	<b>Art Unit</b> 3736	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 11 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-45 is/are pending in the application.
- 4a) Of the above claim(s) 8, 10, 20 and 25-45 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-7, 9, 11-19 and 21-24 is/are rejected.
- 7) ☒ Claim(s) 23 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |                                                                                                    |                                                                             |
|----------------------------------------------------------------------------------------------------|-----------------------------------------------------------------------------|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. _____                                                |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____                                                                        | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Applicant's election without traverse of Species IV, claims drawn to Fig. 20 in the reply filed on January 11, 2006 is acknowledged.
2. Claims 8, 10, 20, and 25-45 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected species, there being no allowable generic or linking claim. Election was made **without** traverse in the reply filed on January 11, 2006.

### ***Specification***

3. The lengthy specification has not been checked to the extent necessary to determine the presence of all possible minor errors. Applicant's cooperation is requested in correcting any errors of which applicant may become aware in the specification.
4. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

### ***Claim Objections***

5. Claim 23 is objected to because the claim language "radius of curvature" measured by inches is indefinite.

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

7. Claims 1-4 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant claims surgical instrument is free of any mechanical connection between the lever and the slide member. The specification lacks definite language disclosing the connection means between the lever and the slide member, making claim 1 indefinite.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

9. Claims 16-19 are rejected under 35 U.S.C. 102(b) as being anticipated by Shutt et al. (5507772). In regard to claim 16, Shutt et al. shows a disposable surgical tool module 140 for use with a separate actuator module 12. The tool module 140 has proximal 144 and distal 146 ends, hollow elongate support member at the distal end of housing 142 with free distal end 146 having an opening, a surgical implement capable of motion in the proximal-distal direction 152, a slide member 154 with a slot 156, the housing 142 having an opening aligned with the slot 156 of slide member 154, and the

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tool module 140 is free from any structure for moving the slide member in the proximal direction (Figure 11). In regard to claim 17, the surgical tool module 140 comprises a kit with an actuator module 140 including a handle 20 and a lever 24 pivotably connected to handle 20 via coupler 26 (Figure 1). In regard to claim 18, Shutt shows an elongate rod 18 and a tissue manipulator 16 in which the elongate rod 18 is received in support member 14. In regard to claim 19, Shutt shows the surgical tool module 140 comprising a spring 204 in the housing (column 14, lines 5, 16-25).

### ***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 1-4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lucey et al. (5782834) in view of Shutt et al. In regard to claim 1, Lucey et al. shows a surgical instrument 10 with a proximal and distal end, a handle 25 curved for gripping, a hollow elongate support member 14, a slide member 34, a slot 94 between the two ends, a lever 24 including a handpiece trigger for gripping, a pivotal connection 136 including an integral drive portion on the other side of the pivotal connection 136 and an integral cam portion (shown in Figure 2, not numbered), and a spring 146. Lucey et al. lacks an integral cam received in the slot in the slide member. Shutt et al. teaches a disposable surgical tool module 140, a slide member 154 having a front end near 140

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and back end near 192, with slot of slide member near 209 for the purpose of receiving integral cam 210 (Figure 16). In regard to claim 2, Lucey et al. shows a handle 25 and proximal opening aligned with slide member 34, a channel 36, an entry slot 94 in connection with the channel 36 (Figure 2). In regard to claim 3, Lucey et al shows a housing around a portion of the slide member 34, which includes a cartridge that is removable from the handle and the lever (Figure 2). In regard to claim 4, the housing has a proximal opening included with suction means 38 aligned with slide member, a distally extending channel 36, and an entry slot 94 in communication with the channel. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Lucey et al. with a slot in the slide member as taught by Shutt et al. since such modification would provide a receiving portion for the cam member.

12. Claims 5-6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steadman et al. (5928252) in view Troutner et al (4091880). In regard to claim 5, Steadman et al. shows a modular surgical instrument 40, an actuator module comprising a handle 44 curved for gripping, an integral support portion shown (not numbered) in Figure 2A comprising the lower portion of housing 21, a lever 42 pivotally connected 43 to support portion of handle, the lever including a trigger portion (curvature indentations shown on lever 42 in Figure 2A) and drive portion (not numbered) includes the region on lever 42 above pivotal connection 43, a trigger portion longer than the drive portion (Figure 2A), a tool module comprising a hollow housing 21, a hollow elongate support member defined as the lower portion of housing, a

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passageway defined by the shaded region between the housing 21 and support member, a surgical instrument 40 capable of motion in the proximal-distal direction (column 3 lines 5-10), a slide member 15. Steadman et al. lacks separate operation of the actuator and the tool modules. Troutner et al. teaches a surgical instrument 20, in which the actuator 22 and tool module 28 are held together by latch 30 (Figures 1 and 2). Additionally, the actuator module may include a power pack for actuating the module providing the capability of the actuator and tool module being assembled and used independently of each other. In regard to claim 6, Steadman et al. shows a slide member 15 with an elongate slot 29 and the housing of the tool module 21 has an opening 23 aligned with the elongate slot 29. In regard to claim 11, Steadman et al. shows a cannula 41. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Steadman et al. with a latch means to disassemble the actuator and tool module as taught by Troutner et al. since such modification would provide for the modules to be used independent of each other.

13. Claim 7 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steadman et al. in view of Matthews et al. (6427351). Steadman et al. shows all of the claimed elements as set forth above including a slide member 15 in the housing 21. Steadman et al. lacks a pair of elongate distance references. Matthews et al. teaches a surgical instrument 10, comprising a handle 36, having a pair of flexible distance references 44 and 46 connected at proximal end 24 of slide member 30, 64 within housing 66 (Figure 2, column 2 lines 35-65). Therefore it would have been obvious for one having ordinary skill in the art at the time of the invention to modify Steadman et al.

with a pair of elongate distance references as taught by Matthews et al. for the purpose of providing the surgical instrument with distance measurement means.

14. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Steadman et al. and Matthews et al. as applied to claim 7 above, and further in view of Burbank et al. (6331166). Steadman et al. shows the slide member 15 in housing 21. Matthews et al. teach a pair of flexible distance references 44 and 46 that are substantially straight and parallel in shape and divergent at the free ends, but lacks disclosure of the material composition of the references. Burbank et al teaches a surgical instrument 10 comprising a cutting element 20 located at proximal end 14 of housing 18. The cutting element 20 is comprised of Nitinol a flexible memory metal (column 4, lines 55-65). Figure 1 illustrates 20 in an arcuate configuration demonstrating the flexibility of the Nitinol material. It would have been obvious for one having ordinary skill in the art at the time of the invention to modify Steadman et al. to include a pair of flexible distance references comprised of Nitinol as taught by Burbank et al. since such modification would provide the distance references flexibility to adapt their shape configuration over a substantial range of distances.

15. Claims 12-15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Steadman et al. in view of Shutt et al. (5507772). Steadman et al. shows all of the claimed elements as set forth above including a tool module housing 21 (Figure 2A) that is fitted with a cannula 128 removably connected by hub 129 (Figure 12, column 9, lines 7-10). Steadman lacks disclosure of other embodiments of the tool module. In regard to claims 12-14, Shutt et al. teaches a surgical instrument 10, comprising a kit including



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a actuator module 12 and tool module 140 wherein the tool module 140 can be replaced with additional tool modules (column 12, lines 42-54), and the handle 12 is sized and shaped to support the housing of the tool module 140 (Figure 12, column 12, lines 22-40). In regard to claim 15, Steadman shows the actuator module 44 and housing of tool module 21 that includes a spring 26 positioned with the slide member 15 to urge the slide member 15 toward the proximal end of housing 21 (column 3, lines 1-5). It would have been obvious to one having ordinary skill in the art at the time of the invention to modify Steadman et al. with a kit comprising an actuator and a plurality of tool modules and a handle sized appropriately as taught by Shutt et al. for the purpose of supporting the housing of the tool module.

16. Claim 21 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shutt et al. (5507772) in view of Matthews et al. (6427351) and Burbank et al. (6331166). Shutt et al. shows a disposable surgical tool module 140. Shutt et al. lacks a pair of elongate distance references made from a shape memory material. Matthews et al. teaches a surgical instrument 10, comprising a handle 36, having a pair and flexible distance references 44 and 46, that are substantially straight and parallel in shape and divergent at the free ends, connected at proximal end 24 of slide member 30, 64 within housing 66 (Figure 2, column 2 lines 35-65). Burbank et al teaches a surgical instrument 10 comprising a cutting element 20 located at proximal end 14 of housing 18. The cutting element 20 is comprised of Nitinol a flexible memory metal (column 4, lines 55-65). Figure 1 illustrates 20 in an arcuate configuration demonstrating the flexibility of the Nitinol material. It would have been obvious for one having ordinary skill in the art at

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the time of the invention to modify Shutt et al. to include a pair of flexible distance references comprised of Nitinol as taught by Matthews et al. and Burbank et al. since such modification would provide the distance references flexibility to adapt their shape configuration over a substantial range of distance measurements.

17. Claims 22-24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shutt et al. in view of Matthews et al. In regard to claim 22, Shutt et al. shows a surgical instrument 10 comprising a handle 20 including a grip portion 22 at proximal end; hollow elongate support member 142 extending outward from handle 20 in distal direction; a surgical implement 152; a lever 24 including a curved trigger portion (bottom 3 curves of Figure 12) pivotably connected to handle 20 via coupler 26, a drive portion (upper portion of 24 Figure 12) and the lever 24 extending through opening 111 in handle 20; slide member 154 having drive surface engaged with drive portion of lever (Figure 12-14). Shutt et al. lacks a pair of elongate distance references and a wedge with distance indicia. Matthews et al. teaches a surgical instrument 10, comprising a handle 36, having a pair and flexible distance references 44 and 46, connected at proximal end 24 of slide member 30 via tubes 40 and 42 and extending out of distal end of cylindrical elongate support member 23 (Figure 1); wherein tubes 42 and 40 extend through discrete elongate tubes 22 and 23 having substantially straight and parallel in shape curved divergent portions at the free ends; wherein distance references 46 and 44 extend through the other end of discrete elongate tubes 22 and 23 having substantially straight and parallel in shape curved divergent portions at beveled free ends. In regard to claim 23, Matthews et al. shows curved portion of elongate tubes having a radius of

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curvature greater than 5 inches (Figure 13). In regard to claim 24, Matthews et al. shows a wedge 39 including distance indicia 72 between the discrete elongate tubes 22 and 23. Therefore it would have been obvious to one having ordinary skill in the art at the time of the invention to modify Shutt et al. with elongate distance references and a wedge including distance indicia as taught by Matthews et al. for the purpose of measuring distance.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kristin D. Rogers whose telephone number is 571.272.7293. The examiner can normally be reached on Monday through Friday 8:00am - 4:30pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Max Hindenburg can be reached on 571.272.4726. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

KDR

  
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